

Reply to Office Action dated June 12, 2008

## REMARKS/ARGUMENTS

Claims 146-165 are pending in the above application.

The Office Action dated June 12, 2008, has been received and carefully reviewed. Each issue raised in that Office Action is addressed below, and reconsideration and allowance of the pending claims is respectfully requested in view of the above amendments and the following remarks.

By this Amendment, paragraph [0005] of the specification has been cancelled and paragraphs [0006] and [0009] of the specification have been amended. Support for the amendments of paragraphs [0006] and [0009] is provided by paragraphs [0006] and [0009], respectively, of the Substitute Specification filed March 6, 2008 (i.e. the corrected English translation of the German-language original description). It is believed that the replacement of "at least one additional component" with "glycol ether component" in paragraph [0006] does not add new matter, as support for "the additional component" being a glycol ether is provided throughout the specification and each of the independent claims expressly recite glycol ethers. Therefore, this replacement is believed to clarify the description in a permissible manner.

Claims 146-148 and 164 have also been amended in order to improve the clarity of these claims. As no substantive change in scope is believed to have resulted from these claim amendments, the support for these claims identified at pages 19-22 of the Remarks filed March 6, 2008 remains applicable and is incorporated herein by reference.

No new matter has been added and claims 146-165 remain pending for examination.

In Sections 1 and 2 of the Office Action mailed June 12, 2008, it was noted that the Substitute Specification filed March 6, 2008 has not been entered, because the marked-up copy of the original English translation filed March 6, 2008 allegedly does not correspond to the originally filed specification (Specification filed September 8, 1998).

In response, the application documents have been checked on the Private PAIR website and it has been found that the document identified as the "Specification" with the date "1998-09-08" is missing several instances of the letter "e" throughout the

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specification. Although the Applicant does not know the actual cause for the deletions of the letter "e", it is suspected that it was caused by a scanning error on the part of the PTO.

The Examiner's attention is directed to the second entry of "Miscellaneous Incoming Letter" dated "1999-01-19" on the Private PAIR page for this application, which document contains a copy of the transmittal letter for this Section 371 filing, a one-page preliminary amendment and a complete English translation of the specification and claims of PCT/EP97/01192. A copy of this document, which is available on the Private PAIR page for this application, is attached hereto for the Examiner's convenience.

It is noted that the English translation provided in the attached document contains a PTO date stamp of "08 Sep 1998" and the application serial no. 09/142452. This English translation appears to have been properly scanned, as there do not appear to be any missing instances of the letter "e". Therefore, it is believed that this English translation actually constitutes the originally-filed English translation of the parent PCT application and it is confirmed that the marked-up copy filed March 6, 2008 is based upon this complete English translation.

Therefore, the Examiner is respectfully requested to expressly confirm that the Substitute Specification has been entered into the record and that further examination will be based upon the Substitute Specification. In addition, the Examiner is requested to enter the Amendments to the Specification (i.e. to the Substitute Specification filed therewith) made in the Amendment filed March 6, 2008.

In addition or in the alternative, it is noted that the Substitute Specification filed March 6, 2008 merely constitutes a corrected English translation of PCT/EP97/01192. All changes noted in the marked-up copy, with the sole exception of the addition of paragraph numbering, find support in the German language original description of PCT/EP97/01192, as was explained in the "Statement pursuant to 37 CFR 1.125(b) and Verification and Translation pursuant to 37 CFR 1.495(f)" of Mr. Jeffrey Tekanic also filed March 6, 2008.

Thus, even if the Examiner still has any concerns with respect to the Substitute Specification, it is requested to enter the Substitute Specification as a replacement

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English translation of the PCT/EP97/01192 that has been verified pursuant to 37 CFR 1.495(f) by Mr. Tekanic. It is believed that the procedure according to 37 CFR 1.125 is not actually required to be followed in order to replace an inaccurate English translation, because the English translation filed September 8, 1998 is not the original description for the present US national stage application. It was merely an attempted English translation of the German language original description provided in PCT/EP97/01192, which included several imprecise translations.

Therefore, in addition or in the alternative, it is requested to waive the requirements of 37 CFR 1.125, as the correction of an English translation of the original description would not appear to require a detailed identification of changes, due to the Verification provided under 37 CFR 1.495(f).

In any event, if the Examiner concludes that the Substitute Specification contains new matter, the Examiner has requested to address the legal authority cited in "Statement pursuant to 37 CFR 1.125(b) and Verification and Translation pursuant to 37 CFR 1.495(f)" of Mr. Tekanic filed March 6, 2008, when explaining how the Substitute Specification allegedly contains new matter. In other words, if it is alleged that the Substitute Specification contains new matter, the Examiner is requested to identify why the original German language PCT specification and claims do not provide support for the Substitute Specification.

In Section 3 of the Office Action mailed June 12, 2008, the amendments to the specification were objected to under 35 U.S.C. 132(a) because these amendments allegedly introduced new matter into the disclosure. Although no specific instances were identified, it was stated that "The amendment changes the scope of the disclosure. The amendment removes recitation of the azeotropic property as the essential property of the cleaning liquids."

In response, paragraph [0005] has been cancelled, although it is believed that this text found support in the original description in accordance with the support identified at pages 19-21 of the Remarks filed March 6, 2008.

As was noted above, paragraphs [0006] and [0009] have been amended in order to re-introduce text found in the original paragraphs [0006] and [0009] of the Substitute Specification. Thus, these amendments are believed to address the Examiner's

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concerns.

Because the pending claims are directed to cleaning methods, in which objects are immersed in the cleaning liquid rather than being exposed to a vapor, it is believed that the amendments made to paragraphs [0007] and [0008] in the Amendment filed March 6, 2008 do not introduce new matter. Paragraph [0069] expressly teaches that vapor cleaning is not an essential element of the invention, as "equally good results ... were also achieved without the vapor treatment". Therefore, removal of description relevant only to non-essential vapor cleaning can not constitute the removal of essential description.

All other amendments to the specification made in the Amendment filed March 6, 2008 have been closely reviewed and are not believed to introduce new matter in view of the entire teachings of the original description. The original description still contains several references to the azeotropic preparation, although it is believed that the original disclosure did not restrict the invention to azeotropic preparations, as indicated, e.g., by paragraph [0019] and the last sentence of paragraph [0059]. In any event, it is noted that the respective concentrations of the liquid cleaning composition will change during usage, e.g., due to evaporation, such that the relative concentrations of the components of the claimed liquid cleaning compositions are not restricted to the relative concentrations found in an azeotropic vapor, if the liquid cleaning composition is brought to its boiling point.

Therefore, the Examiner is respectfully requested to withdraw the objection to the specification.

In Section 4 of the Office Action mailed June 12, 2008, the Examiner objected to the Applicants' election of species, "because the elected compound are not properly identified for the genuses. Further the referenced election contradicts to the presented claims, which recite the composition, **which optionally includes at least one additional organic compound.**" (Emphasis in original)

As an initial matter, it is noted that the Applicants maintain their traverse to the species election requirement and incorporate herein by reference the arguments made at pages 26-28 of the Remarks filed March 6, 2008.

Second, it is noted that claims 146 and 164 have been amended to remove the

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“optional” language. It is believed that the new formulations of claims 146 and 164 have the same scope as the previous formulations and no change in scope is intended by these amendments.

More particularly, the independent claims have been clarified in that the liquid cleaning composition includes at least water and at least one glycol ether in each pending claim. See e.g., liquid (i) of claim 146. In addition, the independent claims cover liquid cleaning compositions including at least water, at least one glycol ether and at least one additional component according to the particularly-recited Markush groups. See e.g., liquid (ii) of claim 146. That is, for example, claim 146 is intended to be interpreted as covering both sets of liquid cleaning compositions covered by the alternative definitions indicated by liquids (i) and (ii).

Third, in an effort to properly identify the elected compounds for the genuses, as was required by the Office Action mailed June 12, 2008, it is noted that a glycol ether is a required component of each independent claim. Therefore, Applicants necessarily elect a genus of liquid cleaning composition that includes a glycol ether. As a species of the claimed glycol ethers, Applicants elect dipropyleneglycolmono-n-propylether.

In addition, Applicants elect a genus of the liquid cleaning composition that also includes an amino alcohol. As a species thereof, Applicants elect L-aminobutanol-2.

Due to the amendment of the claims made after the species election of December 28, 2007, it is believed that the remaining identification of genuses and species made in the Office Action mailed December 28, 2007 is no longer particularly applicable.

Furthermore, it is noted that paragraph [0059] in conjunction with the first entry of Table II expressly discloses a species of liquid cleaning composition that consists of water, dipropyleneglycolmono-n-propylether and L-aminobutanol-2. Therefore, this elected species is a disclosed embodiment and it would seem to be unobjectionable for a disclosed, preferred embodiment to serve as the basis for the Applicants’ species election.

Consequently, it is believed that the species election has been complied with in good faith. If the Examiner has further objections to the Applicant’s species election, it is respectfully requested to more comprehensively explain the basis for the objection, in

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view of the fact that Applicants have elected a disclosed species, i.e. a liquid cleaning composition that consists of water, dipropylene glycolmono-n-propylether and L-aminobutanol-2, and claims 146-164 explicitly cover liquid cleaning compositions that read upon this elected species of the liquid cleaning composition.

Finally, for the record, it is noted that the publication date of JP 08-003592, a computer-generated translation of which was filed with the IDS of June 1, 2004, is January 9, 1996.

### **CONCLUSION**

Each issue raised in the Office Action dated June 12, 2008, has been addressed, and it is believed that claims 146-165 are in condition for allowance. Wherefore, reconsideration and allowance of these claims is earnestly solicited. If the examiner believes that any additional changes would place the application in better condition for allowance, the examiner is invited to contact the undersigned at the telephone number listed below.

#### *Deposit Account Authorization*

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this, concurrent and future replies, including extension of time fees, to Deposit Account 50-3828 and please credit any excess fees to such deposit account.

Respectfully submitted,



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**Date: August 7, 2008**